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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,263	10/19/2001	Robert W. Monster	109888-130239	5037
22918	7590	12/11/2007		
PERKINS COIE LLP P.O. BOX 2168 MENLO PARK, CA 94026			EXAMINER JACKSON, JAKIEDA R	
			ART UNIT 2626	PAPER NUMBER
			MAIL DATE 12/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

10/031,263

### Applicant(s)

MONSTER, ROBERT W.

### Examiner

Jakieda R. Jackson

### Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-11 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-11 and 13-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 19, 2007 has been entered.

### ***Response to Arguments***

2. Applicant argues that Chong's method is focused on translation techniques, whereas applicant's techniques are based on making content selections for email headers, greetings and bodies that while based on a determination of a preferred language, are not focused on actions involving translation of text from one language to another. In response to applicant's argument of Chong's translation, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

It was also discussed that Horman does not disclose applicant's techniques for the automatic generation of language customized emails. According to the amended claims, Applicant's arguments are moot in view of new grounds of rejections.

***Claim Objections***

3. Claim 16 is objected to because of the following informalities:

- Line 1, "The apparat...us" should be --The apparatus--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 2-3, 5-9 and 13-20** are rejected under 35 U.S.C. 102(e) as being anticipated by Scanlan (USPN 7,171,348).

Regarding **claims 2 and 6**, Scanlan discloses a method comprising:

receiving at least one instruction to automatically generate a set of language-specific email messages containing content associated with marketing research (business offering products for sale; column 1, lines 29-41), wherein the at least one instruction includes an indication of a list of recipients and an indication of a pre-assembled content (compiling databases of translated documents; column 8, lines 9-18) set for use in automatically (automatically) generating the set of language-specific

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(provide mirror sites in a range of common languages) email messages containing the content associated with marketing research, the pre-assembled content set including at least a first version of the content in a first language and a second version of the content in a second language (column 1, lines 12-49 and column 2, lines 43-57 with column 4, line 17 - column 5, line 63);

based on the received instruction, automatically generating the set of language-customized electronic mail messages (web pages in multiple languages; column 1, lines 42-49 and column 4, lines 17-29) containing the content associated with marketing research (researching; column 5, lines 1-5), wherein at least a first one of the electronic mail messages is customized for a first recipient having a first language preference, wherein at least a second one of the electronic mail messages is customized for a second recipient having a second language preference, and wherein automatically generating each of the language-customized electronic mail messages (web pages of the web site translated to a number of foreign languages; column 4, lines 17-29) in the set includes:

identifying a preferred language of an electronic mail recipient from the list of recipients (identifies the language of the sender; column 5, line 1 - column 6, line 19);

selecting and writing header information (subject line; column 7, lines 16-25) to an electronic mail message (email address) based on the preferred language (language), wherein the header information includes character coding information that is selected based on the preferred language (unique identify; column 5, lines 22-32);

selecting, from the pre-assembled content set (compiling databases of translated documents; column 8, lines 9-18), a language-appropriate version of the content associated with marketing research based on the identified preferred language (research; column 5, lines 1-63); and

writing a body to the electronic mail message (the communication), wherein the writing includes inserting the selected language appropriate version of the content associated with marketing research (research; column 5, lines 1-63); and

sending each of the language-customized electronic mail messages to an appropriated electronic mail recipient (forwarded to recipient; column 5, lines 1-63).

Regarding **claims 3 and 14**, Scanlan discloses a method and apparatus wherein the preferred language is determined by querying a database of the system (determines if translation is required; column 5, lines 1-21).

Regarding **claims 5 and 16**, Scanlan discloses a method and apparatus wherein the character coding information comprises one or more of MIME-Version header field, a content type header field, a content transfer encoding field and a character set parameter of the content type header field (subject line; column 7, lines 1-25 with column 5, lines 22-32).

Regarding **claims 7 and 18**, Scanlan discloses a method and apparatus wherein the electronic mail message is generated automatically in response to an event of the survey system (column 8, lines 9-18 with column 5, line 1-63).

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Regarding **claims 8 and 19**, Scanlan discloses a method and apparatus wherein the recipient is expressed in a manner dependent on the preferred language (determines language; column 5, lines 1-63 and column 6, lines 52-60).

Regarding **claims 9 and 20**, Scanlan discloses a method and apparatus further comprising sending the electronic mail message to the recipient expressed in the language manner (forwarded directly to the recipient; column 5, lines 1-63).

Regarding **claims 13 and 17**, it is interpreted and rejected for the same reasons as set forth in claims 2 and 6. In addition, Scanlan teaches an apparatus comprising a storage medium having stored therein a plurality of programming instructions designed to perform a plurality of operations and a processor coupled to the storage medium to execute the programming instructions (figure 1).

Regarding **claims 15**, Scanlan discloses an apparatus wherein the programming instructions are designed to include in said header information, character coding information based on the preferred language (unique identify; column 5, lines 1-63).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. **Claims 10-11 and 21-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Scanlan in view of Chong et al. (USPN 5,535,120), hereinafter referenced as Chong.

Regarding **claims 10 and 21**, Scanlan discloses a method and apparatus for sending language based emails, but does not specifically teach culturally appropriate salutation.

Chong discloses a method and apparatus further comprising selecting an at least partially completed, pre-assembled culturally appropriate salutation for the recipient based on the preferred language (sex indicative titles; column 11, lines 7-20 with column 13, lines 35-48), to select applicable sublanguage dictionaries.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Scanlan's method and apparatus wherein it teaches culturally appropriate salutation, as taught by Chong, in order to determine the appropriate core and sublanguage dictionaries to be used for the translation of a given text.

Regarding **claims 11 and 22**, Scanlan discloses a method and apparatus for sending language based emails, but does not specifically teach culturally appropriate salutation.

Chong discloses a method and apparatus comprising automatically completing the at least partially completed, pre-assembled culturally appropriate salutation based on the recipient's name and the preferred language (sex indicative titles; column 11, lines 7-20 with column 13, lines 35-48); and



writing to a body of the electronic mail message the completed culturally appropriate salutation (sex indicative titles; column 11, lines 7-20 with column 13, lines 35-48), to select applicable sublanguage dictionaries.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Scanlan's method and apparatus wherein it teaches culturally appropriate salutation, as taught by Chong, in order to determine the appropriate core and sublanguage dictionaries to be used for the translation of a given text.

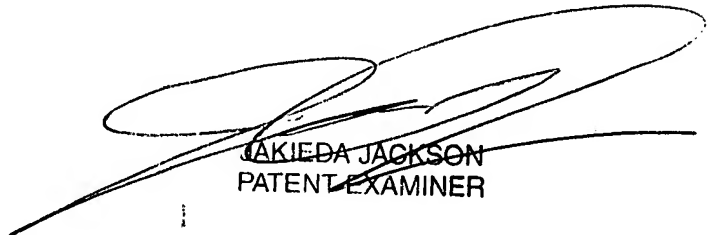
### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jakieda R. Jackson whose telephone number is 571-272-7619. The examiner can normally be reached on Monday-Friday from 5:30am-2:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRJ  
December 6, 2007



JAKIEDA JACKSON  
PATENT EXAMINER